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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,218	06/15/2001	Xiaoling Wang		8460

7590

07/03/2006

Mr. Walter J. Tencza Jr.  
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EXAMINER
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FLETCHER, JAMES A

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/882,218

Applicant(s)

WANG, XIAOLING

Examiner

James A. Fletcher

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 28-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-28, and 31-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Observation***

1. Although there is nothing improper in the claims as written, the Examiner notes that there are two similar groups of claims, those being an apparatus of claim 1 and those claims dependent on claim 1, and a method of claim 21 and those claims dependent on claim 21. In the apparatus claims, claims 12-18 depend on dependent claim 4. In the method claims, claims 32-38, which correspond to apparatus claims 12-18, depend on independent claim 21, instead of dependent claim 24, which corresponds to apparatus claim 4. The Examiner will examine the claims as written, without objection to their form or dependency, but feels this apparent difference is worth mentioning to the Applicant.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 12-18, 20-27, 32-38, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Woo (5,485,219).

**Regarding claims 1, 6, 21 and 26,** Woo discloses an apparatus and method comprising:

- a skipping control device (Col 1, lines 52-54 “a control station having number of controllers associated with each channel of a broadcast area”);

Art Unit: 2621

- and a video recording and playback device including skipping functions (Col 3, lines 38-41 “each VCR 190<sub>i</sub> responds to infrared electromagnetic signals to select a particular channel, and to control recording [i.e., ON, RECORD START, PAUSE, STOP, OFF, for example]”);
- wherein the video recording and playback device receives a video signal (Col 4, lines 1-2 “Those particular processors 180, that are set to record broadcasts associated with the operator’s channel”);
- and wherein the skipping control device receives a content classification signal or management parameter and uses it to determine whether to send a control signal to the video recording and playback device (Col 3, lines 62-68 “When a commercial segment is shown on television monitor 130, the operator actuates OFF switch 164, causing transmitter 150 to broadcast an OFF command associated with the operator’s channel”),
- wherein the control signal affecting operation of the skipping functions of the video recording and playback device (Col 4, lines 4-6 “These particular processors 180<sub>i</sub> transmit the PAUSE command to their associated VCRs 190<sub>i</sub>, causing the VCR 190 to stop recording”).

**Regarding claims 2 and 22**, Woo discloses an apparatus and method wherein the control signal disables the skipping functions of the video recording and playback device (Col 5, lines 4-7 “When processor 180 determines that its identifier matches the identifier in data-type ID 220, it shuts itself off when data portion 230 matches the Kill code”).

**Regarding claims 3 and 23,** Woo discloses an apparatus and method wherein the control signal enables the skipping functions of the video recording and playback device (Col 4, lines 4-6 "These particular processors 180<sub>i</sub> transmit the PAUSE command to their associated VCRs 190<sub>i</sub>, causing the VCR 190<sub>i</sub> to stop recording").

**Regarding claims 4 and 24,** Woo discloses an apparatus and method wherein the skipping control device receives a first management parameter (Col 1, lines 53-54 "controllers associated with each channel of a broadcast area"); and

- wherein the skipping control device uses both the content classification signal and the first management parameter to determine whether to send the control signal to the video playback and recording device (Col 1, lines 54-56 "The controllers include ON and OFF switches that are actuated according to programming content of a particular channel").

**Regarding claims 5 and 25,** Woo discloses an apparatus and method wherein the skipping control device receives a plurality of management parameters (Col 1, lines 54-56 "The controllers include ON and OFF switches that are actuated according to programming content of a particular channel" and Col 4, lines 36-38 "There are three different digital words used in the preferred embodiment: a table word, a channel word, and an identifier word".); and

- wherein the skipping control device uses both the content classification signal and the plurality of management parameters to determine whether to send the control signal to the video playback and recording device (Col 1, lines 54-56 "The controllers include ON and OFF switches that are actuated according

to programming content of a particular channel” and Col 4, lines 41-43 “When data-type ID 220 includes the channel word, processor 180 uses data in data portion 230 to control recording of its associated VCR 190”).

**Regarding claims 7 and 27**, please see Examiner’s remarks regarding claims 5 and 25.

**Regarding claims 12 and 32**, Woo discloses an apparatus and method wherein the first management parameter identifies a television channel (Col 1, lines 54-56 “The controllers include ON and OFF switches that are actuated according to programming content of a particular channel”).

**Regarding claims 13 and 33**, Woo discloses an apparatus and method wherein the first management parameter identifies a television program (Col 2, lines 12-15 “Programs to be recorded are identified by name, and the processor will start and stop the VCR at the appropriate time, and eliminate commercials during the broadcast, if desired by the user”).

**Regarding claims 14 and 34**, Woo discloses an apparatus and method wherein the first management parameter identifies a television program classification (Col 1, line 67 – Col 2, line 4 “The operators actuate their OFF switches when programming is presented on the television that is not to be recorded. Similarly, the operators actuate their ON switches when programming to be recorded is broadcast”).

**Regarding claims 15-16 and 35-36**, Woo discloses an apparatus and method wherein the first management parameter identifies a date and time that the video signal was recorded (Col 5, lines 15-18 “In the preferred embodiment, data portion 230

Art Unit: 2621

includes programming data representing a particular date, channel and time when an identifier appears in data-type ID 220").

**Regarding claims 17-18 and 37-38**, Woo discloses an apparatus and method wherein the first management parameter identifies a user subscription level to a service (Col 8, lines 4-8 "This feature allows broadcast recording control system 100 operator to selectively deactivate specific processors 180<sub>i</sub>, such if a user has not paid a monthly use fee, for example").

**Regarding claims 20 and 40**, Woo discloses an apparatus and method wherein the plurality of parameters are comprised of a complete disabling parameter that causes the skipping control device to completely disable the skipping functions of the video playback and recording device independent of the content classification signal (Col 5, lines 4-7 "When processor 180 determines that its identifier matches the identifier in data-type ID 220, it shuts itself off when data portion 230 matches the Kill code").

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo as applied to claims above, and further in view of Zigmond et al (6,698,020).

**Regarding claims 11 and 31**, Woo discloses a system wherein a commercial killer service can be terminated as analyzed and discussed above, but does not

specifically disclose a system wherein the commercial skipping feature is disabled and the regular program skipping feature is enabled.

Zigmond et al teach a commercial insertion system wherein the commercial cannot be avoided (Col 13, lines 33-36 “a selected advertisement is displayed simultaneously on all of the multiple channels, so the advertiser ensures that instant coverage is made to viewers watching any of a large number of channels”), while not enforcing viewing of regular program material (Col 13, line 17 “channel surfers”).

As suggested by Woo and taught by Zigmond et al, enforcement of viewing of advertisements while allowing the user the ability to skip programming that is uninteresting to him or her is well known in the prior art, providing an advertiser with confidence that his advertising message is presented to the audience while allowing the user to select regular programming to his or her taste.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Woo in order to enforce viewing of commercial messages while allowing the viewer to skip regular programming material.

6. Claims 19 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo as applied to claims above, and further in view of Ebisawa (5,886,731).

**Regarding claims 19 and 39,** Woo discloses an apparatus and method wherein a commercial is skipped based on a subscription or a level thereof as analyzed and discussed above, but does not specifically disclose an apparatus and method wherein a quantity of commercial skips is dependent on that subscription level.



Ebisawa teaches a system wherein the subscription level allows a ratio of program to commercial time over a specific time period (Col 18, lines 47-54 "The charge demanding systems, such as demanding the payment corresponding to the ratio of the program data viewing time and the CM data viewing time to the viewers, demanding the payment determined with the type of the program data and the CM data viewed by the viewer, and demanding the payment determined with the type and amount of the program data and the CM data viewed by the viewer, can be realized easily").

As suggested by Woo and taught by Ebisawa, a commercial elimination device based on a limit of commercials eliminated in a given time period is well known, providing the user with the ability to determine his preferred number of commercials viewed versus the money spent on avoiding viewing of commercials.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woo in order to provide for a given number of commercials eliminated in a given time period based on a customer preference.

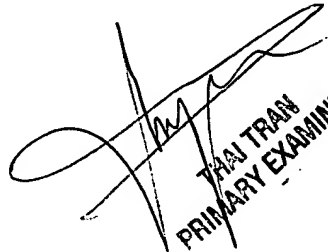
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (571) 272-7377. The examiner can normally be reached on 7:45-5:45 M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JAF  
26 June 2006



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PRIMARY EXAMINER